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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,655

07/06/2007

Yoshitsugu Morita

71,051-039

8161

27305

7590

10/26/2009

HOWARD & HOWARD ATTORNEYS PLLC  
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EXAMINER

NELSON, LINDSAY ANN

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/26/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/584,655	<b>Applicant(s)</b> MORITA ET AL.	
	<b>Examiner</b> LINDSAY NELSON	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/06/2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. The spacing of the lines of the specification is such as to make reading difficult. New application papers with lines 1½ or double spaced on good quality paper are required.
2. Claim 11 objected to because of the following informalities: claim 11 states "any of claim 1". The phrase "any of" should be removed. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 12 provides for the use of the cured product of claim 11, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an

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improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

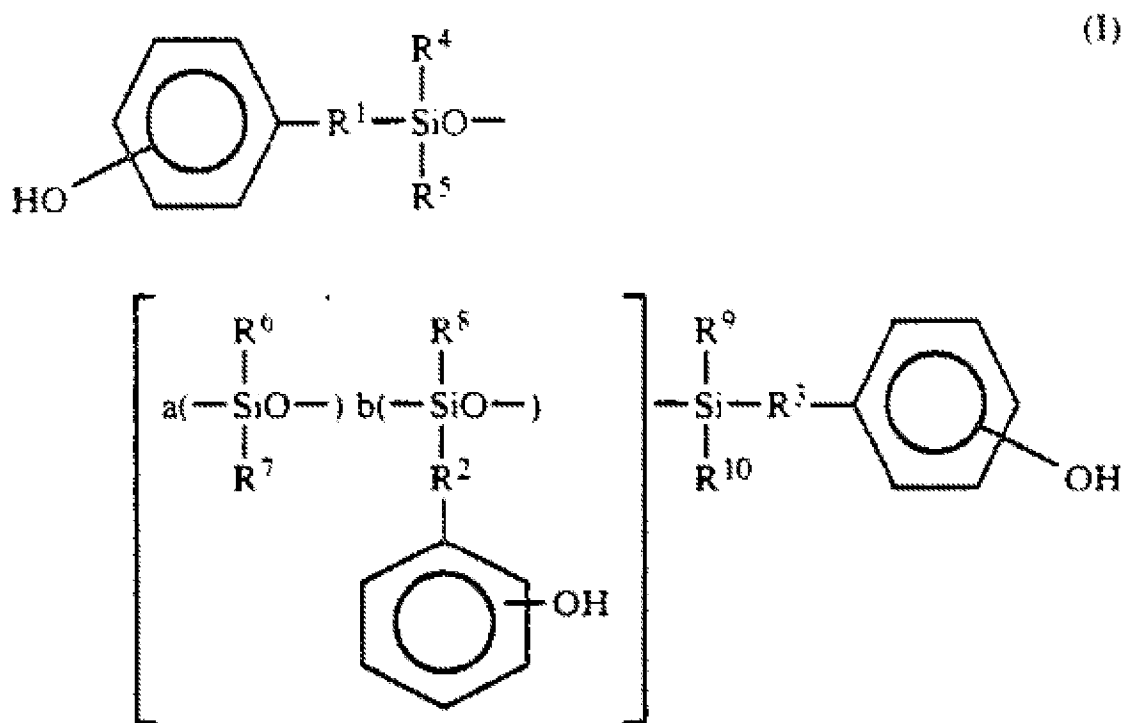
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

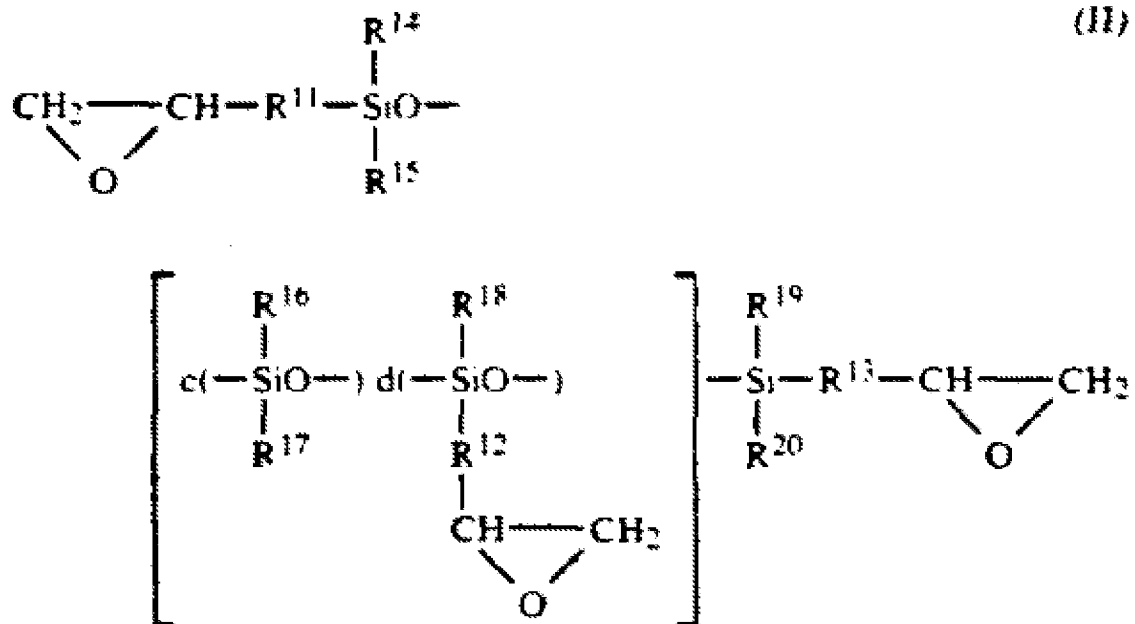
4. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito et al, US Patent Number 5,114,994 (hereinafter Ito).

5. Regarding claims 1, 3, 6 - 7, and 11-12, Ito discloses an epoxy resin composition for sealing a semiconductor which contains a flexibilizer which is made from silicone containing hydroxyphenyl groups on ends of and/or in its molecules which is formed of a copolymer of a denatured silicone oil A having hydroxyphenyl groups and denatured silicone oil B having epoxy groups (abstract). The denatured silicone oil A has the general formula (I)

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Wherein R<sup>1</sup>-R<sup>3</sup> is a bivalent organic group, R<sup>4</sup>-R<sup>10</sup> represents alkoxy groups, or hydroxyalkyl groups having 1-10 carbon atoms, a is an integer of from 5 to 300, and b is from 0 to 10 (column 2, lines 38-66). The denatured silicone oil B has the general formula (II)



Wherein R<sup>11</sup>-R<sup>20</sup> is a bivalent organic group, R<sup>14</sup>-R<sup>20</sup> represents, alkoxy groups or hydroxyalkyl groups having 1-10 carbon atoms, c is an integer of from 5 to 300, and d is from 0 to 10 (column 2 line 67-column 3 line 25). Furthermore, Ito discloses that a hardening accelerator (or curing accelerator) such as imidazole, are added to the composition (column 10, lines 15-23) which reads on the claimed composition.

6. Regarding claims 2, 13, and 16 - 17, Ito further discloses that the composition should further include a filler such as a silica filler, a talc filler or a mica filler (column 10 lines 33 - 39) which reads on the claimed composition which further comprises a filler.

7. Regarding claims 4 and 14, Ito does not disclose the component A comprising a SiO<sub>4</sub> groups. However, because either of instant formulas (1) or

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(2) may be used in the composition without leading to unexpected results, the compositions of Ito is deemed anticipatory over the claimed composition.

8. Regarding claims 5, 10, 15, and 20, Ito discloses that the components A and B are silicone oil, which is a liquid. While Ito does not disclose that the composition is a liquid or paste, one skilled in the art would realize that, because the compositions are substantially similar to one another, they would have the same properties and thus the composition of Ito would also be liquid or paste.

9. Regarding claims 8 and 18, Ito further discloses an example wherein 60 parts by weight of silicone oil A and 100 parts by weight of silicone oil B are used (Examples 2 to 5). Furthermore, Ito discloses that the hardening accelerator in the composition should comprise 0.03 to 2 percent by weight of the composition (column 10, lines 24 – 32) which reads on the claimed composition.

10. Regarding claims 9 and 19, Ito further discloses the epoxy resin employed as the main component as a tris(glycidoxyphenyl)methane (column 3 line 63, - column 4 line 1), which reads on the claimed use of glycidoxy groups in the composition.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSAY NELSON whose telephone number is (571)270-7735. The examiner can normally be reached on Monday - Thursday, 9 am - 5 pm est.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LN

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796